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09/915,701	07/26/2001	Tadao Matsuzuki	SUZ-007	9347
26717	7590	09/09/2005		
RONALD CRAIG FISH, A LAW CORPORATION PO BOX 820 LOS GATOS, CA 95032			EXAMINER OUELLETTE, JONATHAN P	
			ART UNIT 3629	PAPER NUMBER
DATE MAILED: 09/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/915,701

Applicant(s)

MATSUZUKI, TADAO

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20010726, 20020214, 20020903
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Handwritten signature or mark.

## DETAILED ACTION

### Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 6, 7, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
3. Regarding claims 6, 7, 16 and 17, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
4. Regarding claims 7 and 17, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

### Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-5, 8-15, and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Coley et al. (US 5,790,664).**

7. As per **independent Claim 1**, Coley discloses a license management apparatus on a customer side, which makes a license agreement of software and/or a use apparatus that installs the software, comprising: report information storage means for storing report information that pertains to the license agreement (C4, L1-21, client module, licensing record); elapsed time measurement means for detecting an elapse of a predetermined term, and outputting detection information (Fig.2, time); and report information output means for automatically sending the report information as use information to a predetermined destination in response to the detection information input from the elapsed time measurement means (Fig.2, C4 L1-52).
8. As per Claim 2, Coley discloses wherein the report information that pertains to the license agreement is apparatus use information indicating that the use apparatus is in use (C6, L53-67, application in use inherently includes apparatus in use).
9. As per Claim 3, Coley discloses wherein the report information that pertains to the license agreement is software use information indicating that the use apparatus has installed the software (C6, L53-67, application in use inherently includes application installed).
10. As per Claim 4, Coley discloses wherein the software use information contains version information of the software (C14 L13-27, version information a part of license record).
11. As per Claim 5, Coley discloses wherein the use apparatus is a personal computer (Fig.1, 100).
12. As per Claim 8, Coley discloses wherein said report information output means includes transmission/reception means connected to one of a radio line, telephone line, Internet, and intranet (Fig.1, 116).

Art Unit: 3629

13. As per Claim 9, Coley discloses a license alert processing device connected to said transmission/reception means (Abstract, Fig.2, 227, Prompt user to take action).
14. As per Claim 10, Coley discloses wherein said license alert processing device generates alert display information upon receiving an alert command via said transmission/reception means (Abstract, Fig.2, 227).
15. As per **independent Claim 11**, Coley discloses a license management apparatus comprising: report information storage means for storing report information that pertains to a license agreement from a plurality of use apparatuses under management (C5 L31-45, commercial environment, client module); elapsed time measurement means for detecting an elapse of a predetermined term, and outputting detection information (C6 L24-28, periodically); and report information output means for automatically sending the report information as use information to a predetermined destination in response to the detection information input from the elapsed time measurement means (C6 L10-52).
16. As per Claim 12, Coley discloses wherein go said report information storage means is connected to the plurality of use apparatuses under the management via communication means, and stores report information that pertains to the license agreement of each use apparatus (C6 L10-52, licensing module cache).
17. As per Claim 13, Coley discloses wherein said report information output means sends the number of the plurality of use apparatuses under the management as the use information when said report information output means outputs the report information as the use information (C6 L53-67, client use and proliferation).

18. As per Claim 14, Coley discloses wherein said report information output means sends the number of copies of software installed in the plurality of use apparatuses under the management as the use information when said report information output means outputs the report information as the use information (C6 L53-67, client use and proliferation).
19. As per Claim 15, Coley discloses wherein the use apparatus is a personal computer (Fig. 1).
20. As per Claim 18, Coley discloses wherein said information storage means, elapsed time measurement means, and report information output means are equipped in a relay server (Fig. 3, 304).
21. As per Claim 19, Coley discloses wherein said report information output means includes transmission/reception means connected to one of a radio line, telephone line, Internet, and intranet (Fig. 1).
22. As per Claim 20, Coley discloses a license alert device connected to said transmission/reception means (Fig. 2, 227).
23. As per Claim 21, Coley discloses wherein said license alert processing device generates alert display information and sends the information to the plurality of use apparatuses under management upon receiving an alert command via said transmission/reception means (Fig. 2, 227).
24. As per **independent Claim 22**, Coley discloses a license management apparatus comprising: report information storage means for receiving report information that pertains to a license from a customer, which is sent via communication means (C4, L1-21, client module, licensing record); check means for comparing the report information from the customer with corresponding registered information, and checking if the comparison result satisfies a

predetermined condition (Fig.2, C4 L1-52); and transmission means for, when the check result of said check means does not satisfy the predetermined condition, outputting alert information and sending the alert information to a terminal of the customer, and for, when the check result satisfies the predetermined condition, sensing key information that allows the terminal to continue operation (Fig.2, C4 L1-52).

25. As per Claim 23, Coley discloses wherein the key information contains a plurality of pieces of key information (Fig.2, license ID information).

26. As per **independent Claim 24**, Coley discloses a license management method wherein a user apparatus which is granted use permission, or a user apparatus that uses software which is granted use permission comprises means for storing condition information used to update the use permission (C4, L1-21, client module, licensing record), and sends the condition information used to update the use permission to a management apparatus that granted the use permission (Fig.2, C4 L1-52), and the management apparatus that granted the use permission checks contents of the condition information used to update the use permission, and sends key information to the use apparatus only when the contents satisfy an update condition (Fig.2, C4 L1-52).

### ***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**28. Claims 6, 7, 16 and 17 are rejected under 35 U.S.C. 103 as being unpatentable over Coley.**

29. As per Claims 6, 7, 16 and 17 as understood by the Examiner, **Coley** does not expressly show wherein the use apparatus is a vehicle such as a passenger vehicle, motorbike, auto truck, home electric appliance such as a television receiver, refrigerator, or the like, and the like, and said report information output means includes a radio device.

30. However, Coley does disclose attaching software for managing license information to a computer/electronic apparatus (abstract); and it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the software to any electronic apparatus with computing/smart electronic capability.

31. Furthermore, Coley discloses transmitting licensing information over a networked/internet environment (Fig.1); and it would have been obvious to include wireless technology (wireless networking/ wireless internet technology/ radio wave transmitting) in the system disclosed by Coley, since such technology was well known at the time the invention was made for use in mobile technology information transfer.

### ***Conclusion***

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

33. The following foreign patent is cited to show the best foreign prior art found by the examiner:



**PCT No. WO 9311480 A1 to BAINS et al.**

Bains discloses a system for administration, on a computer network, of license terms for a software product provided to said network.

34. The following non-patent literature is cited to show the best non-patent literature prior art found by the examiner:

**“Macrovision to Acquire GLOBEtrotter, Leading Supplier of B2B Electronic Software Licensing Technologies “, Business Wire, March 28, 2000.**

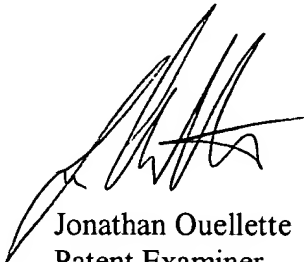
Business wire discloses a system by Globetrotter that manages software licensing information.

35. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.
36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

Art Unit: 3629

38. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

September 6, 2005



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600